UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,385	10/16/2001	Christopher S. Piddington	99-24C1	4574

7590 08/27/2002

Phillip B.C. Jones, J.D., Ph.D.
ZymoGenetics, Inc.
Patent Department
1201 Eastlake Avenue East
Seattle, WA 98102

EXAMINER
MOORE, WILLIAM W

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/978,385	PIDDINGTON ET AL.	
	Examiner	Art Unit	
	William W. Moore	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-3, drawn in part, and claims 4-6 and 15 drawn specifically, to a carboxypeptidase having the amino acid sequence of SEQ ID NO:2, to a composition comprising the carboxypeptidase, classified in class 435, subclass 226.

II. Claims 7-12 and 15, drawn to a polynucleotide encoding a carboxypeptidase having the amino acid sequence of SEQ ID NO:2 from at least position 19 through position 738, to vectors or recombinant viruses comprising the polynucleotide, to host cells comprising the polynucleotide, to a composition comprising a vector comprising the polynucleotide, and to a recombinant method of making of a first encoded carboxypeptidase in a host cell using the polynucleotide, classified, *inter alia*, in class 536, subclass 23.2.

III. Claims 13 and 14, drawn to antibodies, classified in class 530, subclass 387.1.

IV. Claim 16, drawn to an alternate method of use of a polynucleotide encoding the amino acid sequence of SEQ ID NO:2 from at least position 19 through position 738 in a method of detecting gene expression, classified in class 435, subclass 6.

V. Claims 1-3 and 17 drawn, in part, to a carboxypeptidase having the amino acid sequence of SEQ ID NO:6 from at least position 19 through position 738, classified in class 435, subclass 226.

VI. Claims 1-3 and 17 drawn, in part, to a carboxypeptidase having the amino acid sequence of SEQ ID NO:9 from at least position 19 through position 738, classified in class 435, subclass 226.

VII. Claims 18-20, drawn, in part, to a polynucleotide encoding a carboxypeptidase having the amino acid sequence of SEQ ID NO:6 from at least position 19 through position 738, to vectors comprising the polynucleotide, and to host cells comprising the polynucleotide, classified, *inter alia*, in class 536, subclass 23.2.

VIII. Claims 18-20, drawn, in part, to a polynucleotide that encodes a carboxypeptidase having the amino acid sequence of SEQ ID NO:9 from at least position 19 through position 738, to vectors comprising the polynucleotide, and to host cells comprising the polynucleotide, classified, *inter alia*, in class 536, subclass 23.2.

The inventions are distinct, each from the other, because of the following reasons:

Inventions of Group I and Group II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products, or, (2) that the product as claimed can be made by another and materially different

process (MPEP §806.05(f)). In the instant case the product of Group I may also be made by another and materially different process such as solid-phase chemical synthesis.

Inventions of Groups I, V, and VI are patentably distinct, one from another, because each is a separate, naturally-occurring, product having distinct amino acid compositions, primary structures, and catalytic activities, and have insufficient structural similarity, one to another, to constitute species of a single genus.

Inventions of Group I and Groups IV, VII and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together, and have different modes of operation and different functions, as well as have different effects.

Inventions of Group II and Group IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP §806.05(h)). In the instant case the product as claimed can be used in a materially different process, that of recombinant production of an encoded carboxypeptidase in a transformed host cell.

Inventions of Group II and Groups V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and have different effects.

Inventions of Groups II, VII and VIII are patentably distinct, one from another, because each is a separate, naturally-occurring, product having distinct nucleic acid compositions and coding capacities and have insufficient sequence similarity, one to another, to constitute species of a single genus.

Inventions of Group III and Groups I, II and IV-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different

effects. (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and have different effects.

Inventions of Group IV and Groups I and V-VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together and have different modes of operation, different functions, and have different effects.

Inventions of Group V and Groups VI and VIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together, and have different modes of operation or different functions, as well as different effects.

Inventions of Group V and Group VII, while not claimed as such, may be related by a process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products, or, (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). In the instant case the product of Group V may also be made by another and materially different process such as solid-phase chemical synthesis.

Inventions of Group VI and Group VIII, while not claimed as such, may be related by a process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products, or, (2) that the product as claimed can be made by another and materially different process (MPEP §806.05(f)). In the instant case the product of Group VI may also be made by another and materially different process such as solid-phase chemical synthesis.

Inventions of Group VI and Group VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects.

(MPEP §806.04, MPEP §808.01). In the instant case the different inventions are not disclosed as capable of use together, and have different modes of operation, different functions, and different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR §1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR §1.48(b) and by the fee required under 37 CFR §1.17(h).

A telephone call was made to Mr. Phillip B. C. Jones on August 23, 2002, to request an oral election to the above restriction requirement, but did not result in an election being made.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William W. Moore whose telephone number is 703.308.0583. The examiner can normally be reached from 8:00AM-6:30PM EST on Mondays, Wednesdays, and Fridays and from 11:30AM-6:00PM EST on Tuesdays and Thursdays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy can be reached at 703.308.3804. The fax phone numbers for the organization where this application or proceeding is assigned are 703.308.4242 for regular communications and 703.308.0294 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0196.

William W. Moore
August 23, 2002

PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600